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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,196	03/10/2005	Wataru Karasawa	08072.0004-00000	1111
22852	7590	11/24/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
ALMATRAHI, FARIS S				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/527,196

**Applicant(s)**

KARASAWA, WATARU

**Examiner**

FARIS ALMATRAHI

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 9-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03/10/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of the Application*

1. This action is in reply to applicant amendment filed August 1, 2008.
2. **Claim 1-8** have been cancelled.
3. **Claims 9-12** are new.
4. **Claims 9-12** are pending.

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features recited in claims 9-12 such as an alarming step of determining by a computer whether the machine is normal or abnormal based on the physical quantity indicated by the operation condition data acquired in the operational condition data acquisition step and based on a reference physical quantity, and generating a predetermined alarm by an output unit when determining that the machine is abnormal, an operating time detecting step of acquiring an operating time of the machine, and computing an index value that indicates a quantified productivity of the machine must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 9-12** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9-12 recite the limitations "data acquisition unit", "an alarming unit", "generating a predetermined alarm by an output

unit" and recites the feature "computing an index value". There is no disclosure in the specification of the instant application supporting these limitations. Applicant is requested to review amended claims to ensure every feature included in the claims is supported in the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (US Patent No. 7,065,570 B2) in view of Spira et al. (US Patent No. 7,269,569 B2).

Fukushima, as applied above shows all of the limitations of the claims except for specifying acquiring, by a sensor, operation condition data representing a physical quantity indicating an operation condition, and an alarming step of determining by a computer whether the machine is normal or abnormal based on the physical quantity indicated by the operation condition data acquired in the operational condition data acquisition step and based on a reference physical quantity, and generating a predetermined alarm by an output unit when determining that the machine is abnormal. Fukushima shows a system and method comprising acquiring an operating time of the

machine by a measuring unit that measures a time during which the machine is turned on in a predetermined service period (Column 4 lines 20-42); a quantifying step of computing an reference value that indicates a quantified productivity of the machine over the predetermined service period based on the operation time (Abstract, Column 2 lines 54-63, Column 6 lines 4-50, Column 19 line 59 - Column 20 line 19); comparing the productivity of the machine quantified in the quantifying step with a predetermined productivity reference to compute a difference between the quantified productivity and the reference productivity (Abstract, Figure 15, Column 5 lines 24-50); and a charge amount determining step of reading charge information for converting the difference between the quantified productivity of the machine and the reference productivity from a charge reference value storage unit and determining an amount of charge for the maintenance service in the service period based on a difference between the charge information and the difference computed by the comparing unit in the comparing step (Abstract, Figure 15, Column 6 lines 4-50, Column 17 lines 14-45, Column 19 line 59 – Column 20 line 19).

Spira teaches acquiring, by a sensor, operation condition data representing a physical quantity indicating an operation condition (Figure 12, Column 5 lines 36-45), and an alarming step of determining by a computer whether the machine is normal or abnormal based on the physical quantity indicated by the operation condition data acquired in the operational condition data acquisition step and based on a reference physical quantity, and generating a predetermined alarm by an output unit when determining that the machine is abnormal (Figure 13, Column 4 line 62 – Column 5 line 11).

Based on the teaching of Spira et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Fukushima et al. reference to include acquiring, by a sensor, operation condition data representing a physical quantity indicating an operation condition, and an alarming step of determining by a computer whether the machine is normal or abnormal based on the physical quantity indicated by the operation condition data acquired in the operational condition data acquisition step and based on a reference physical quantity, and generating a predetermined alarm by an output unit when determining that the machine is abnormal in order to take advantage of current reliable technology.

### **Response to Arguments**

6. Applicant's arguments with respect to 35 U.S.C. 102 rejections have been considered but are moot in view of the new ground(s) of rejection.
7. Objection to the IDS filed on March 10, 2005, as detailed in previous action, has not been overcome. The "concise statement of relevance" referred to by the applicant in the argument filed on February 26, 2008 has not been received.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571)270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Faris Almatrahi  
Examiner  
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/F. Ryan Zeender/  
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